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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,541	06/17/2005	Larry B. Brandenburger	160-P-1617USWO	7511

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/523,541	Applicant(s) BRANDENBURGER ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 23 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4, 6 to 8, 10, 11, 13 to 23 is/are rejected.
- 7) ☒ Claim(s) 5,9 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The language "as described herein" is improper.

2. Claims 1 to 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Reference to "the total weight of polyols" lacks antecedent basis since no polyols are specifically found.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Toman et al.

Toman et al. teach a thermosetting polyester coating. Please see column 4, line 30 and on, including Example 1. This teaches a coil coating composition. The composition contains approximately 35 wt% of an asymmetric diol (2-methyl-1,3-propane diol) and approximately 65 wt% of symmetric diol. The polyester is formed from tere/iso-phthalic acids, an aromatic dicarboxylic acid. It is applied to a coil and cured. This meets claim 21.

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6. Claims 1-4, 6-8, 10, 11, 13-20, 22 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Toman et al.

Toman et al. teach thermosetting polyester coatings. As can be seen on column 1, line 47 and on, the polyester requires the presence of a non-symmetrical glycol reactant, 2-methyl-1,3-propane diol, to achieve the desired results. Again, please note the composition prepared in Example 1. This differs from that claimed in that it does not specify the glass transition temperature of the polyester.¹

Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. If applicants are of the position that the prior art does not, in fact, possess the same properties as the claimed composition, the claimed composition should be amended to distinguish itself from the prior art.

While the Examiner realizes she cannot read limitations into the claims from the specification, she refers the specification which details an inherent property of the claimed composition. Page 5, lines 20 and on, refer to the storage stability of the polyester resin as its ability to not crystallize when stored. This property is also found in the prior art composition. See the top of column 5. The fact that both polyesters have the same storage stability lends support to the Examiner's position that another inherent property, glass transition temperature, will be the same. Note that both of these properties are the result of the combination of asymmetric and symmetric diols.

For claim 2, see column 4, line 19.

For claim 3, see Example 1.

For claim 4, note that this allows for a combination of aromatic dicarboxylic acid. Example 1 meets this limitation.

For claims 6 and 7, see Example 5 which contains approximately 69.5 wt% symmetric diol.

¹ Please note that this coating exhibits a "lack of cracking" in a zero T flexibility test. The "lack of cracking" appears to be the same thing as "no tape off" since "no tape off" means that none of the coating cracks when tape is snapped off.

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For claim 8, note that both neopentyl glycol and 1,6 hexanediol are used in the examples, both of which are embraced by this claim.

All of the working examples meet claim 11.

For claim 13, see the melamine component in Example 1.

For claim 14, see column 3, line 39, which specifically teaches melamine formaldehyde resin.

For claim 15, note the above position on glass transition temperature.

For claims 16 and 18, see column 2, lines 59 and 62.

For claim 17, note that this is the solvent mixture used in the examples.

For claims 19, 20 and 22, the Examiner acknowledges that these properties are not taught in the prior art. Comparable to that detailed above, please note that where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. See MPEP 2112 (III).

Specifically, for claims 19 and 22, the Examiner realizes that two of the coating compositions in Toman et al. are measured for hardness and have a value of F. Note, thought, that many other polyester compositions are prepared by Toman et al. that meet the requirements for the claimed polyester, wherein the hardness is not measured. It is the Examiner's belief that these compositions can inherently fall within the claimed hardness requirement.

7. Various other references are cited as being of general interest. Please note that neither Algrim et al. reference is prior art in the instant application due to their filing date of 10/29/02 and the instant priority date of 8/15/02. The remaining reference cited teach various polyester compositions that contain at least one asymmetric diol but do not adequately teach or suggest each of the requirements found in the claims.

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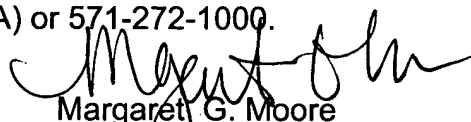
8. Claims 5, 9 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

For claim 5, note that Toman et al. do not allow for more than 40 wt% of isophthalic acid (column 2, line 29). For claims 9 and 12, there is not adequate suggestion to use 1,3 propane diol. Column 2, lines 37 and on, teaches ethylene glycol and 1,4 butane diol, as non-preferred diols to be used other than 1,6 hexane diol. This simply fails to provide motivation to use 1,3 propane diol.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
1/6/07